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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,486	06/28/2001	Uwe D'Agnone		3163

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EXAMINER

PARSLEY, DAVID J

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/892,486

Applicant(s)

D'AGNONE ET AL.

Examiner

David J Parsley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Amendment

1. This office action is in response to applicant's amendment dated 7-12-04 and this action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations of the major opposing surface areas including only adhesive therebetween and the minor opposing surface areas being adhesively bonded in claims 10 and 28, are not supported in applicant's disclosure. As seen in applicant's figure 2 upon removal of the minor surface areas – at 4-5, from the major surface areas the human hand is located between the major surface areas and therefore adhesive is not the only thing located between the major

surface areas. Further, there is no mention in applicant's disclosure of the minor surface portions – at 4,5 being bonded together or more specifically adhesively bonded together.

Claim Rejections - 35 USC § 102

32. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-14, 16, 22-25, 28-29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,210,975 to Beckerman.

Referring to claims 10 and 28, Beckerman discloses a paper product comprising first and second paper sheets – see figures 1-9, each having first and second opposite paper surfaces with the first paper surface being in substantially planar contiguous surface-to-surface opposing relationship at both major and minor opposing surface area portions thereof – see for example figures 1-9, the major – at 14 and minor – at 12, opposing surface area portions of the first and second paper sheets first paper surfaces being adhesively bonded to each other – see for example column 3 lines 36-51, a line of perforations in the first and second paper sheets which is adapted to be torn to facilitate the separation of the major and minor opposing surface area portions from each other – see for example column 5 lines 52-63, the major opposing surface area portions being devoid of germination seeds therebetween and including only adhesive therebetween – see for example at 14 in figures 1-9 and column 4 lines 42-57, a germinative seed – at 16, housed

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and confined between the adhesively bonded minor opposing surface area portions – see for example at 12 in figures 1-9, and the adhesively bonded minor opposing surface area portions and the confined germinative seed housed therein can be entirely bodily removed as a plantable unit from the major opposing surface area portions along the lines of perforations for subsequent planting absent adversely affecting, damaging or destroying the major opposing surface area portions – see for example figures 1-9. Further, the limitations of the minor opposing surface area portions and the seed being entirely removed from the major opposing surface area portions as a plantable unit for subsequent planting constitutes functional language pertaining to the function of the apparatus and therefore has been considered but does not render the claims distinguishable over the Beckerman reference see in, *In re Dally*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) and MPEP section 2114. Further, Beckerman discloses a plurality of paper products per claim 28 as seen in column 5 lines 1-63 and Beckerman further discloses means for connecting the plurality of paper products as seen in figure 9 and column 5 lines 1-63.

Referring to claims 11 and 22, Beckerman discloses the line of perforations is a substantially continuous line of perforations – see for example figures 1-9 and column 5 lines 52-63.

Referring to claims 12 and 23, Beckerman discloses the line of perforations has opposite ends – see for example figures 1-9 and column 5 lines 52-63.

Referring to claims 13-14, 24-25 and 32, Beckerman discloses the line of perforations extend substantially between edges and/or opposite edges of the sheets – see for example figures 1-9 and column 5 lines 52-63.

Referring to claim 16, Beckerman discloses the minor opposing surface are portions – at 12, of the first and second paper sheets first paper surfaces are adhesively bonded to each other – see for example figures 1-9 and column 3 lines 36-51.

Referring to claim 29, Beckerman discloses the connecting means are located along a common edge of the pairs – see for example figure 9 and column 5 lines 1-63.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beckerman as applied to claims 10 and 16 above, and further in view of U.S. Patent No. 3,940,884 to Mason. Beckerman does not disclose the line of perforations is a substantially closed line of perforations. Mason does disclose the line of perforations – at 10, is a substantially closed line of perforations – see for example figures 2 and 4. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Beckerman add the line of perforations being a closed line of perforations of Mason, so as to allow for the perforated portion to be easily removed while leaving the shape of the device to stay intact.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckerman as applied to claim 10 above, and further in view of U.S. Patent No. 5,860,245 to Welch.

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Beckerman further discloses that the major opposing surface area portions are adhesively bonded to each other – see for example figures 1-9 and column 2 lines 36-51. Beckerman does not disclose a decomposable adhesive bonds the major surface area portions. Welch does disclose a decomposable adhesive bonds the major surface portions – see column 3 lines 3-10. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Beckerman and add the decomposable adhesive of Welch, so as to make the paper product more effective in promoting the plant seed to grow since the adhesive is decomposable and environmentally friendly and thus won't harm the growth of the seed into a plant.

Claims 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beckerman as applied to claims 10 and 16 above, and further in view of U.S. Patent No. 4,168,002 to Crosby. Beckerman does not disclose a means for indicating the presence of the germinative seed between the minor opposing surface area portions. Crosby does disclose a means – see column 3 lines 44-52 for indicating the presence of the germinative seed between the minor opposing surface area portions – 17 and 18. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Beckerman and add the means for indicating the presence of the seed of Crosby, so as to allow for one to verify the seed is between the minor surface area portions of the paper product without damaging the paper product.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckerman as applied to claim 10 above, and further in view of U.S. Patent No. 4,838,580 to Tuhkanen or U.S. Patent No. 5,158,809 to Proctor or WO Patent No. 94/00975 to Poret. Beckerman does not disclose the major opposing surface area portion provides means for defining an address field. Tuhkanen, Proctor and Poret do disclose the major opposing surface area portion – 6f of

Tuhkanen, - 13 of Proctor and - 16 of Poret provides means for defining an address field— see for example figures 1-8 and column 2 lines 60-65 of Tuhkanen, figures 1-2 of Proctor and figure 1 of Pore. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Beckerman and add the major surface areas with address field of Tuhkanen, Proctor or Poret, so as to make the paper product more user friendly since the address field won't be interfered with as the seed grows into a plant, thus allowing the user to be able to read the address field at all times.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckerman as applied to claim 10 above, and further in view of U.S. Patent No. 4,418,497 to Mastriano or U.S. Patent No. 5,062,229 to Werjefelt. Mastriano and Werjefelt do disclose the major opposing surface area portion provides means for defining an inscription field - 36 of Werjefelt and - 14 of Mastriano. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Beckerman and further add the means for defining an inscription field of Mastriano or Werjefelt, so as to make the paper product more visually pleasing in that inscriptions can be placed onto the paper product.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckerman as applied to claim 10 above, and further in view of U.S. Patent No. 5,062,229 to Werjefelt. Beckerman does not disclose the major opposing surface area portion provides means for defining a calendar field. Werjefelt does disclose the major opposing surface area portion provides means for defining a calendar field - 30 - see for example figures 1-5. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Beckerman and add the major surface area portion providing means for defining a calendar field

of Werjefelt, so as to allow for the paper product to not be wasted and immediately discarded in that the calendar can be used throughout the year.

Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beckerman as applied to claim 28 above, and further in view of Werjefelt. Beckerman does not disclose each of the pairs defines a calendar field and/or a post card field set off by each line of perforations. Werjefelt does disclose each of the pairs – 24 and 26 defines a calendar field – 30 – see figures 1-2 and/or a post card field – 26 set-off by each line of perforations – 22 – see for example figures 1-2 and column 3 lines 25-50. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Beckerman and add the pairs defining a calendar field and/or a post card field of Werjefelt, so as to allow for the paper product to not be wasted and immediately discarded in that the calendar can be used throughout the year and that the paper product can be made flexible in that it has many different uses.

Response to Arguments

5. Regarding claims 1 and 28, applicant claims that the minor opposing surface area portions and the germinative seed housed therein can be entirely bodily removed as a plantable unit with the operative word being “can”. The word “can” meaning it is capable of being planted and as seen in figures 1-9 of the Beckerman reference US 5210975, the seeds and minor opposing surface area portions as seen at item – 12 are configured so that they are capable of being planted. Further, as seen in figure 7b, the seeds and minor opposing surface area portions are shown in a position to be transplanted into the ground since as the tree seeds sprout and the tree grows the tree needs to be eventually planted in the ground as it increases in size.

Further, the major opposing surface areas – at 14,30-34 of Beckerman contain only adhesive therebetween when the soil – at 18, is removed from the major surface areas – at 14 and then added into the minor surface areas – at 12 as seen in figures 7a-7b and column 4 lines 42-57.

Regarding all of the 35 U.S.C. 103(a) rejections listed above in paragraph 4 of this office action, applicant relies upon the arguments corresponding to claims 1 and 28 and therefore refer to the response to those arguments above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on 9hr compressed.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Parsley
Patent Examiner
Art Unit 3643


PETER M. POON
SUPERVISORY PATENT EXAMINER
9/10/04